

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

MAKOTO NUMAKAWA et al.

Serial No: 10/565,769

Confirmation No.: 3001

Filed: March 9, 2006

For: MAINTENANCE APPARATUS FOR
MEDICAL HAND PIECE

Art Unit: 3732

Examiner: Eide, Heidi Marie

APPELLANT'S REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In reply to the Examiner's Answer which was originally mailed on December 16, 2010, and then remailed on January 6, 2011, Appellant has carefully reviewed the Examiner's Answer and would like to Reply to the Examiner's Answer as set forth in the paragraphs below.

IN REPLY TO THE REJECTION UNDER 35 U.S.C. 112, SECOND PARAGRAPH

The Examiner has rejected the Claim 12 under 35 U.S.C 112, second paragraph stating that claim 12 is not only drawn to the maintenance apparatus alone but also positively claims the hand piece with a recycling passage. Appellant respectfully submits that the hand piece with recycling passage is not positively claimed in the Claim 12. Particularly, in Claim 12 it claims:

"The connector (33) has a recycling passage (37) which is so designed to be detachably connected to a feeding passage (43) of the hand piece (12) and said feeding passage (36) can be detachably connected to a recycling passage (44) of the hand piece (12)".

Appellant respectfully submits that the connector (33) is part of the maintenance apparatus and only its function is defined in the above described quotation from Claim 12. Still further Claim 12 further states or claims:

“The maintenance fluid can be fed through the feeding passages (36, 43) of the connector (33) and the hand piece (12) to the bearing (48, 49) of the hand piece (12)”

Appellant respectfully submits that the above statement merely describes how the fluid is fed and its intended use. Also, Claim 12 claims:

“...said maintenance fluid fed through said nozzle supply (40) through the recycling passages (37, 44) of the connector (33) and the hand piece (12) when the connector (33) is connected to said hand piece (12)”.

Again Appellant respectfully submits that the language above merely discloses the collection of the fluid after it has performed its function. In view of the above, Appellant respectfully submits that the hand piece is not positively claimed in the claims.

IN REPLY TO THE REJECTIONS UNDER 35 U.S.C. 102 AND 35 U.S.C. 103

In the Examiner's Response to Arguments beginning at page six of the Examiner's Answer and particularly on page seven, the Examiner states that “Brown only has to be capable of functioning as claimed and Brown does not have to provide a suggestion”. Appellant respectfully submits that if one views Figure 2 and Figure 4 of Brown, it is clear that in Figure 2 it only describes that cleaning fluid is dropped from the capsule (20) into the main air hole (11) of the hand piece (10) (see column 5, lines 1-6). In contrast thereto, Appellant's invention as is claimed in the second paragraph of Claim 9 requires that the maintenance fluid supply nozzle be fluidly connected to a second fluid supply and the maintenance fluid supply nozzle is designed to fit into and be detachably connected to the chucking structure in place of the rotary tool so that

the maintenance fluid is fed through the nozzle and into the chucking structure. Appellant respectfully submits that Figure 2 and the description associated therewith does not disclose such a structure.

Still further, Figure 4 and the associated description (see column 3, lines 18-24) clearly show that the capsule (30) drips a maintenance composition onto the chucking structure with the rotary tool still provided therein. Clearly neither Figure 1 nor Figure 4 of Brown discloses a structure capable of fitting the supply nozzle into the chucking structure in place of the rotary tool. Still further, Appellant respectfully submits that Examiner is incorrect when he states that Brown does not have to provide a showing, suggestion or teaching of the apparatus functioning as claimed. Clearly if Brown shows a structure which suggests away from what the Examiner suggests it is capable of, then it is mere conjecture to say that Brown is capable of functioning as the Examiner suggests.

In addition the Examiner suggests that the dimensions of the nozzle are merely a design choice and is merely a matter of intended use of the device with the tool. As discussed above, nowhere in Brown does it show inserting the capsule (20) or (30) into the chucking structure after the rotary tool has been removed. Therefore, Appellant respectfully submits that the shape and dimension of the nozzle, if one is shown at all, is not Appellant's invention.

In view of the above, therefore, Appellant respectfully submits that Brown is not capable of functioning as claimed.

Again, the Examiner suggests that the apparatus taught by Hoffman only needs to be capable of functioning as claimed. Appellant directs the Examiner's attention to the adapter (10) and it is clear from the adapter (10) that there is no nozzle designed so as to fit into and be detachably connected to the chucking structure in place of the cutting tool. Instead, there is an adapter (10) which allows a fluid supply to be screwably connected thereto and providing fluid connection to the communication passages in the hand piece and nowhere in Hoffman does it

show any nozzle which fits into and is detachably connected to the chucking structure in place of the rotary tool and in fact in Figure 6 shows the cutting tool (204) in the chucking structure. Appellant respectfully submits that the only way that Hoffman could be utilized in the manner of Appellant's invention would be to completely remove the dental drill lubricating device (10), remove the rotary tool (204) from the chucking device (202) and then connect the fluid supply hose (248) in some manner to the chucking device. Appellant respectfully submits that this requires a number of steps not suggested by Hoffman or shown in Hoffman and which are entirely against and in opposition to the use or function of the invention of Hoffman. Accordingly, Appellant respectfully submits that not only is Hoffman not capable of performing the function of Appellant's invention as claimed but also one of ordinary skill in the art would not look to Hoffman for a maintenance fluid supply nozzle designed so as to fit into and be detachably connected to a chucking structure in place of a rotary tool so that the maintenance fluid is fed through the nozzle and into the chucking structure.

Still further and as to DeRocchis, Appellant respectfully submits that DeRocchis does not show or suggest a nozzle to be inserted into the chuck structure instead of the rotary tool and Appellant directs the Examiner's attention to Figure 3b, 5 and 1. In all three figures there is no nozzle inserted into the chucking structure and in Figure 1 there is still a cutting tool provided in the chucking structure. In addition, Appellant respectfully submits that Appellant's Claim 13 requires that the nozzle which is inserted into the chucking structure in place of the rotary cutting tool have at least one hole for injecting the maintenance fluid in the form of a mist. The Examiner suggests that DeRocchis teaches a nozzle having a hole for injecting a maintenance fluid in the form of a mist and directs Appellant's attention to column 3, lines 38-41. Appellant respectfully submits that column 3, lines 38-41 refer to Figure 5 and state:

"...the agent is made to contact exterior portions of the tool. Preferably the disinfectant is disbursed as a mist which contacts the exterior of the tool."

Appellant respectfully submits that the language above and the figure does not show, suggest or teach a structure which would be capable of injecting maintenance fluid into the chucking structure after the cutting tool has been removed and instead merely discloses spraying a mist on the exterior of the hand piece for disinfecting.


CONCLUSION

In view of the above arguments, Appellant respectfully submits that Appellant's claims are not anticipated by nor obvious over the art relied upon by the Examiner.

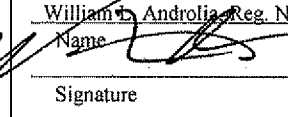
Any fees required to enter this reply brief may be charged to DLA Piper Deposit Account No. 07-1896.

Respectfully submitted,

By:


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